

REMARKS/ARGUMENTS

Claims 14-15, 17-21 and 23-25 are active in this case.

In the Official Action, the Examiner has raised a new rejection combining the previously cited Egel-Matani patent (U.S. 6,110,703) with the *S. pombe* database reportedly published on February 21, 2002 and Hombergh.

As noted in the Action, the present application claims priority to PCT/JP02/05223 filed May 29, 2002 and JP2001-160128 filed May 28, 2001. Certified English translations of these documents are attached hereto. Applicants request that the Office recognize this claim of benefit. Further, the JP2001-160128 shows that inventors had reduced to practice a method of constructing *S. pombe* strains by deleting or inactivating one or more genes in that strain for producing a heterologous protein as of May 28, 2001, which is prior to the February 21, 2002 date on which the the *S. pombe* database was reportedly published.

Further, as explained previously the role of a certain gene and its effects, when deleted in one yeast are different from a corresponding or similar gene in another yeast species. For example, *S. pombe* has greater than 60 protease genes and the effect of removing those on the production of heterologous proteins would not have been clear to one in this field when the application was filed. As there was no guidance in the art nor expectation of success as to which genes (regardless of whether the sequences were known) could be deleted to enhance heterologous protein production, the claims would not have been obvious.

Reconsideration of the rejection is requested.

As to the provisional rejections citing to co-pending application 12/025,138, Applicants request that the rejection be held in abeyance since the alleged conflicting claims have not yet been patented. Further, Applicants note the following from MPEP § 822.01:

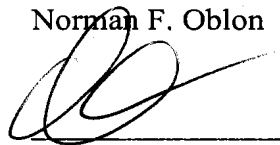
The "provisional" double patenting rejection should continue to be made by the examiner in each application as long as there are conflicting claims in more than one application unless that "provisional" double patenting rejection is the only rejection remaining in one of the applications. If the "provisional" double patenting rejection in one application is the only rejection remaining in that application, the examiner should then withdraw that rejection and permit the application to issue as a patent, thereby converting the "provisional" double patenting rejection in the other application(s) into a double patenting rejection at the time the one application issues as a patent.

Applicants also request a Notice of Allowance for all pending claims.

Respectfully submitted,

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